REMARKS

In the Office Action dated January 10, 2008, the Examiner alleges that this application contains the following groups of inventions that are allegedly independent and distinct from each other according to 35 U.S.C. §121:

Group 1, Claims 1-17 and 20, drawn to compounds of formula I, wherein A=B=furan, and the linker is -O-CH_2-C_6H_4-CH_2-O-, and the linker and the benzofuran oxygen have meta relationship.

Group 2, Claims 1-17 and 20, drawn to compounds of formula I, wherein A=B=furan, and the linker is -O-$(CH_2)_n$-O-, and the linker and the benzofuran oxygen have meta relationship.

Group 3, Claims 1-17 and 20, drawn to compounds of formula I, wherein A=B=furan, and the linker is -S-$(CH_2)_n$-S-, and the linker and the benzofuran oxygen have meta relationship.

Group 4, Claims 1-17 and 20, drawn to compounds of formula I, wherein A=B=furan, and the linker is -N-$(CH_2)_n$-N-, and the linker and the benzofuran oxygen have meta relationship.

Group 5, Claims 1-17 and 20, drawn to compounds of formula I, wherein A=B=furan, and the linker is –O-CH_2-HET-CH_2-O–, wherein HET is furan, thiophene, thiadiazole, pyridine, pyrimidine, pyrazine or pyridazine, further the linker and the benzofuran oxygen have meta relationship.

Group 6, Claims 1-17 and 20, drawn to compounds of formula I, wherein A=B=furan, and the linker is other than ones indicated in Groups 1-5, and the linker and the benzofuran oxygen have meta relationship. Election of species is required.

Group 7, Claims 1-17 and 20, drawn to compounds of formula I, wherein A and B are not furan, and the linker is other than ones indicated in Groups 1-5. Election of species is required.

Group 8, Claims 1-17 and 20, drawn to compounds of formula I, not included in Groups 1-7. Election of species is required.

Group 9, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 1.

Group 10, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 2.

Group 11, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 3.

Group 12, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 4.

Group 13, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 5.

Group 14, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 6.

Group 15, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 7.

Group 16, Claim(s) 18, 19, drawn to method of treating various diseases using the compound of Group 8.

In order to be fully responsive to the Examiner's requirement for restriction under PCT Rule 13.1, and under 35 U.S.C. §121, applicants provisionally elect, with traverse, to prosecute the subject matter encompassed by Group II, encompassing the subject matter of Claims 1-17 and 20, drawn to compounds of formula I, wherein A=B=furan, and the linker is O-$(CH_2)_n$-O, and the linker and the benzofuran oxygen have meta relationship.

In order to comply with the reply to the Requirement, the Office Action requires an election of a species or invention to be examined and identification of the claims encompassing the elected invention.

In compliance therewith, applicants reiterate the election of Group II. Moreover, Claims 1-6, 10-15, 17 and 20 read on the elected invention.

Applicants respectfully request that the Restriction Requirement be withdrawn since it is not in compliance with 35 U.S.C. §§121, 37 C.F.R. 1.141 and 1.142 and 1.499.

35 U.S.C. §121 provides that the Commissioner may restrict an application when two or more <u>independent</u> and <u>distinct</u> inventions are claimed in a single application (emphasis

added). Similarly, 37 C.F.R. §1.141(a) permits restriction on condition that independent and distinct inventions are found within one application. However, the Office Action has not made out a *prima facie* case to support a restriction requirement as it has not shown that the various groups are independent and distinct. In fact, it has not even alleged that the groups are independent and distinct.

Moreover, Groups 1-16 are not independent and distinct to justify a Restriction Requirement. For example, Groups 1-16 are not independent. In fact, applicants submit that there is an interdependence between each of the groups alleged to be patentably distinct.

MPEP §802.01 defines independent as follows:

> The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is they are unconnected in design, operation or effect...

Applicants respectfully submit that the subject matter in Groups 1-16 are connected in design, operation or effect and are thus not independent.

The subject matter of Groups 1-16 all recite compounds having a basic generic structural framework, i.e., all the claims include a compound of Formula I having common definitions of R_1, R_2, R_3, R_4, R_5 and R_6. Further, these compounds all posses properties and utilities, such as those recited in Claims 18-19. Thus, Groups 1-16 are related and are not independent. They therefore have a disclosed relationship. Consequently, because these groups of claims are connected in design, operation and/or effect and are therefore not independent, the claims which the Office Action has grouped separately are not "independent and distinct" so as to justify the Restriction Requirement. It is therefore respectfully submitted that the Restriction Requirement is improper and cannot be maintained.

Further a requirement for restriction presupposes an analysis of the subject application in light of the rules governing this practice, i.e., 37 C.F.R. §1.499 and PCT Rules 13.1 and 13.2. PCT Rule 13.1, first sentence, states: "The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention')." (Emphasis added.) PCT Rule 13.2 states: "The expression "technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (Emphasis added.)

The Examiner alleges that the inventions listed as Groups 1-16 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, these groups lack the same or corresponding special technical features. Specifically, the Examiner contends that the non-variable element is present in all of the groups is also present in commercially available well-known khellinone and that the claimed subject matter is not a contribution over the prior art.

To the contrary, the subject matter of the various groups are linked to form a single general inventive concept, and thus a restriction requirement in this case is improper. There is unity of invention between Groups 1-16. More specifically, as indicated hereabove, the compounds in Groups 1-16 have a common generic basic structural framework. They also exhibit common properties and utilities as recited in Claims 18 and 19. Accordingly, the various groups form a single general inventive concept.

Applicants respectfully submit that unity of invention, not novelty, is the issue at hand. Applicants should be given the opportunity to argue the merits during prosecution, i.e.,

whether the claims are novel over prior art. Restriction of the claims at this stage would deny Applicants such an opportunity.

The Applicants respectfully disagree with Examiner's conclusion at the bottom of page 3 of the Office Action that the claimed subject matter does not represent a contribution over the compound khellinone. Comparing the structures on page 4 of the specification with the generic inventive structure on page 5 clearly shows that the compound khellinone is not identical with the claimed subject matter. Therefore, there is no apparent basis for concluding that the claimed compound is not a contribution over the prior art. It is respectfully submitted that the claimed subject matter provide a clear contribution over the compound khellinone, which was cited by the Examiner. Consequently, the various groups are not distinct, as alleged in the Office Action. Accordingly, withdrawal of the restriction requirement is respectfully requested.

In the least, Group 2, directed to the compounds and Group 10, directed to the methods should be examined together "Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding "special technical features". The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. MPEP, Administrative Instructions Under the PCT, Annex B. Further, paragraph e(i) of the Administrative Instructions Under the PCT, Annex B explicitly permits distinct categories of inventions to be examined together. This explicitly applies to an independent claim for a given product, and an independent claim for a use of the said product.

Therefore, in accordance with current Unity of Invention practice, it is respectfully submitted that the claims directed to the compounds of Group 2, should be examined

together with the claims of Group 10 that are directed to the methods of using the compounds of Group 2. These groups of claims are related as product claims and claims directed toward methods of using the product.

Nevertheless, applicants respectfully submit that there is unity of invention with respect to all of the groups, for the reasons given hereinabove.

Consequently, inasmuch as there is a unity of invention, it is respectfully requested that the restriction requirement be withdrawn.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein, so as to encourage applicants to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner recognized by 35 U.S.C. §112, all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to either conduct simultaneous prosecution with attendant filing fees and costs or face a compromise of the term of their patent

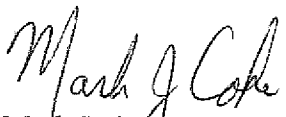
assets.

It is therefore vital to all applicants that Restriction Requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double-patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention-double-patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting claim that arises after the issuance of a patent on the divisional application.

All of these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicants respectfully urge the Examiner not to require restriction in cases such as the present application.

Hence, it is respectfully requested that the United States Patent and Trademark Office reconsider and withdraw the requirement for restriction pursuant to 35 U.S.C. §121 and provide an action on the merits with respect to all of the claimed subject matter.

Respectfully submitted,



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